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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------|-------------|----------------------|--------------------------------|------------------------|
| 10/729,040 | 12/05/2003 | Kai Desinger | 3002 | 9336 |
| 7590 Beck & Tysver, P.L.L.C. Suite 100 2900 Thomas Avenue S. Minneapolis, MN 55416 | | 09/24/2007 | EXAMINER VRETTAKOS, PETER J | |
| | | | ART UNIT 3739 | PAPER NUMBER |
| | | | MAIL DATE 09/24/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,040

Applicant(s)

DESINGER ET AL.

Examiner

Peter J. Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8-23-07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The instant action is non-final. RCE filed 8-29-07.

The application is a continuation of PCT/EP02/05778 filed 6-7-01. The Applicant is required to list this information at the beginning of the Specification.

Claims 1-3 and 5-19 are pending and addressed below. Claim 1 is lone independent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5-8, 10-17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Arndt et al. (6,134,476).

Arndt discloses a coaxial probe arrangement (700) in figure 7 with inner (710) and outer (706) conductors ("metal tubes") with annular insulation/tube (708) between and first (702,"tip") and second external (716, "shaft") electrodes, as well as a hand portion (704 – "insulation jacket", handle, also see figure 5) with first and second blind bores (region D3 where 710 rests and the distal most area where 702 rests, respectively – also the first bore is inherently able to pass a "spring wire"). Region D1 and D2 includes transverse bores (in which 720 and 722 rest).

Design placement of inner conductor (710), which is metallic, inherently provides an increased flexural (bending) stiffness of the probe (700).

Arndt discloses saline (col. 23:19-23, *inter alia*), which can be of varying concentrations including those concentrations of lesser conductivity, anticipating claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arndt in view of Berube et al. (6,245,062).

There is no express mention of screws in Arndt.

Berube discloses an analogous microwave antenna in which the shaft (31) is screwed to the handle (38). See col. 11:40-45.

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Arndt in view of Berube by including as design expedients screws in a microwave antenna. The motivation would be to choose a design expedient that prevents the separate antenna parts from disassembling.

Response to Arguments

Applicant's arguments filed 8-29-07 have been fully considered but they are not persuasive.

The Applicant attempts to import structure through the use of "means for" language. The structure is that which results in certain internal forces. In response, the Office simply reiterates prior Response to Arguments (see below). The inherent ambiguity in relying upon non-tangible internal forces in one's arguments simply cannot obviate a rejection because the prior art neglects to mention non-tangible internal forces. (Mention of internal forces in a device's description is extremely rare in the prosecution of the electrosurgical arts.) The Examiner is not empowered to unequivocally say the prior art above does not disclose (explicitly or implicitly) the claimed non-tangible forces.

The Applicant is asking the Examiner to make dispositive the claimed presence of internal forces (stresses) resulting from the manner in which the invention is built. The Examiner is not aware of any aspect of patent law in which claimed internal forces will make a claim patentable or even provide patentable weight. The Examiner asks for case law showing this.

The Applicant points out examples in the original disclosure including screws and nuts. What is still unclear is how the screws and nuts result in the claimed stresses. The prior 35 USC 112 is obviated by the examples provided in the specification. However, the patentable weight of the claimed stress limitation is minimal because it provides no tangible structure. As such, the prior rejections are maintained notwithstanding the prior

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art's lack of express disclosure toward internal forces, which is unheard of to the Examiner in claim language or even in the specification of electrosurgical patents.

The Examiner is left asking what can possibly be shown in the prior art to address the claim language that a connection is "in such a way" that the inner conductor is under tensile stress while the outer conductor is under a compression stress. Not only is the connection's "such a way" characteristic not described in the Specification, but there is no way, barring an explicit statement in the prior art, that the Examiner can prove the prior art has or does not have a connection "in such a way" as the Applicant now claims. As such, the connection limitation is properly afforded very little patentable weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

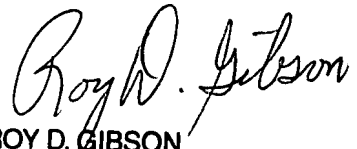
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
September 13, 2007




ROY D. GIBSON
PRIMARY EXAMINER